



Docket No.: 241850US3

COMMISSIONER FOR PATENTS
ALEXANDRIA, VIRGINIA 22313

OPEN
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ATTORNEYS AT LAW

RE: Application Serial No.: 10/645,614

Applicants: Norimasa SOHMIYA, et al.

Filing Date: August 22, 2003

For: IMAGE FORMING APPARATUS

Group Art Unit: 2852

Examiner: CHEN, S. S.

SIR:

Attached hereto for filing are the following papers:

RESPONSE TO NOTICE OF NON-RESPONSIVE REPLY

Our check in the amount of **\$0.00** is attached covering any required fees. In the event any variance exists between the amount enclosed and the Patent Office charges for filing the above-noted documents, including any fees required under 37 C.F.R. 1.136 for any necessary Extension of Time to make the filing of the attached documents timely, please charge or credit the difference to our Deposit Account No. 15-0030. Further, if these papers are not considered timely filed, then a petition is hereby made under 37 C.F.R. 1.136 for the necessary extension of time. A duplicate copy of this sheet is enclosed.

Respectfully submitted,

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IN THE UNITED STATES PATENT & TRADEMARK OFFICE

IN RE APPLICATION OF :

NORIMASA SOHMIYA, ET AL. : EXAMINER: CHEN, S. S.

SERIAL NO: 10/645,614 :

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SIR:

In response to the Office Communication dated December 8, 2004, applicants replace the list of provisionally elected claims with the following list: Claims 1-15, 18-31, 34-40, 45-45 and 53-55. It is respectfully submitted that Claim 3 is generic with respect to non-elected Claims 16 and 17, Claim 19 is generic with respect to non-elected Claims 32 and 33, and Claim 37 is generic with respect to non-elected Claims 41-44 and 46-52.

In the Election filed October 25, 2004, applicants respectfully traversed the restriction requirement based on the decision of the Director of the U.S.P.T.O. described in *In re Kase*, 71 USPQ2d 1063 (U.S.P.T.O. Director 2004) (unpublished). The *Kase* decision states that if no reasons are given to show why claims are independent and/or distinct other than a statement that the claims are directed to a different invention, then the Restriction Requirement is improper and should be withdrawn. See *Kase* at 1064.

However, page 2, paragraph 2 of the Office Communication of December 8, 2004 states that *In re Kase* applies to product/process restriction only. Applicant respectfully

disagrees with this conclusion. Nothing in the opinion states that the holding is to be read so narrowly.

The original allowed claims of U.S. Patent Application No. 09/878,413 (now U.S. Patent No. 6,818,308) included both method and apparatus claims. Accordingly, the restriction was not between product and process claims, despite the fact that all of new restricted Claims 13-22 were process claims. Thus, it is respectfully submitted that the holding of *In re Kase* requires that reasons be provided for all restriction requirements, regardless if they are between species, between product and process claims, or for any other reason.

As no reasons were given in the Restriction Requirement as to why the claims are independent and/or distinct, it is respectfully requested that the Requirement to elect a single invention be withdrawn, and that a full examination on the merits of Claims 1-57 be conducted.

Respectfully submitted,

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